

REMARKS

Reconsideration of the present application and entry of the amendment are respectfully requested. Claims 38 to 57 are currently pending, claims 43 and 50 have been canceled, and claims 38 to 57 have been amended.

The Office Action mailed December 19, 2002 addressed claims 38 to 57. Claims 38 to 57 were rejected:

The claims were objected to, and the Examiner stated that the numbering of claims was not in accordance with 37 CFR. § 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. The Examiner concluded that misnumbered claims were renumbered as claims 38 to 57.

Applicants thank the Examiner for renumbering the claims. The claims have been amended to reflect the renumbering, and to correct the dependency of the claims with the new claim numbers. Applicants respectfully submit that this overcomes the objection to the claims.

Claims 38 to 42, 44, 45, 47, 48 and 51 to 56 were rejected under 35 U.S.C. § 102(e) as being anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over Yamagishi et al. (5,779,563). Regarding claim 38, the Examiner stated that Yamagishi discloses a golf ball comprising a solid core, an inner cover layer and an outer cover layer, the inner cover layer is made from Himilan (an ionomer), and the outer cover is made from polyurethane and has a Shore D hardness from 40 to 68. Regarding claim 40, the Examiner stated that the ball has a diameter of 42.7 mm or 1.68 inches, regarding claim 42, the outer cover layer has a Shore D hardness of 40 to 68, regarding claims 44 and 45, the outer cover layer has a thickness of 0.3 to 2.5 mm or 0.01 to 0.098 inches, and regarding claim 47, the solid core is made from a polybutadiene, the outer cover layer is made from polyurethane and has a Shore D hardness of 40 to 68. Regarding claims 51 and 52, the Examiner stated that the outer cover layer has a thickness of 0.3 to 2.5 mm or 0.01 to 0.098 inches, regarding claim 53, the solid core is made from a polybutadiene, the inner cover layer is made from Himilan, and the outer cover is made from polyurethane and has a Shore D hardness from 40 to 68. Regarding claim 55, the Examiner stated that the ball has a diameter of 42.7 mm or 1.68 inches. Regarding claims 39, 41, 48, 54 and 56, the Examiner stated that Applicant claims a PGA compression and coefficient of restitution, and the properties are obvious over Yamagishi because Yamagishi discloses a solid golf ball comprising a

polybutadiene core, an ionomeric cover and a polyurethane outer cover, and Applicant claims the same materials disclosed by Yamagishi for each layer. The Examiner further stated that although Yamagishi is silent, one skilled in the golf ball art is aware that golf balls commonly have a PGA compression between 70 and 100, and the COR has a common range in the golfing art between 0.7 and 0.8. The Examiner concluded that one of ordinary skill in the art would have modified the values of the properties to obtain the desired flight characteristics of the golf ball.

Although Applicants respectfully disagree with the Examiner regarding the rejection, in an effort to hasten prosecution, claims 38, 47 and 53 have been amended to incorporate the limitation of claims 43 and 50, which are not anticipated by, or alternatively, obvious over Yamagishi et al. Claims 38, 47 and 53 claim a golf ball with a core having a PGA compression of 55 or less. Applicants respectfully submit that Yamagishi et al. does not disclose a golf ball with a core having a PGA compression of 55 or less, nor does Yamagishi et al. provide any suggestion or teaching to make a golf ball wherein the core has a PGA compression of 55 or less. Yamagishi also does not disclose a golf ball having the claimed PGA compression and the claimed COR.

For at least these reasons, Applicants respectfully submit that claims 38 to 42, 44, 45, 47, 48 and 51 to 56 are not anticipated under 35 U.S.C. § 102(e) by, or in the alternative, obvious under 35 U.S.C. § 103(a) over Yamagishi et al. Applicants therefore respectfully request that the rejection of claims 38 to 42, 44, 45, 47, 48 and 51 to 56 be reconsidered and withdrawn.

Claims 38 to 57 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 37 of U.S. Patent No. 5,971,870 in view of Yamagishi et al. (5,779,563). The Examiner stated that the present invention and the '870 patent claim golf balls comprising a solid core and a cover layer, where each layer has identical properties. The Examiner further stated that the present invention further claims a single and dual cover layer, and the dual cover layer comprises an inner cover layer made from an ionomer and an outer cover layer made from polyurethane. The Examiner further stated that the '870 patent claims an outer cover made from an ionomer and does not claim an inner cover layer, but Yamagishi teaches a golf ball comprising a single or dual cover, where the inner cover is an ionomer resin, and Yamagishi also teaches an outer cover made from ionomer resins or polyurethanes. The Examiner concluded that one of ordinary skill in the art would have modified the '870 patent in view of Yamagishi by adding an additional cover layer and a polyurethane outer

cover layer to obtain a more durable golf ball.

Although Applicants respectfully disagree, in an effort to hasten prosecution, Applicants herein submit a Terminal Disclaimer which disclaims the terminal portion of any patent granting from the instant application, as required under MPEP § 1490. Applicants respectfully submit that this overcomes the rejection.

The Examiner is invited to telephone Applicants' attorney if it is deemed that a telephone conversation will hasten prosecution of the application.

CONCLUSION

Applicants respectfully request reconsideration and allowance of each of the presently rejected claims, claims 38 to 57. Applicants respectfully request allowance of claims 38 to 42, 44 to 49 and 51 to 57, the claims currently pending.

Respectfully submitted,

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